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JJGJR:109-04

Paper No: 21

FISH & RICHARDSON, PC
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SAN DIEGO CA 92130-2081

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OCT 29 2004

OFFICE OF PETITIONS

ON PETITION

In re Application of
Castiel, et al :
Application No. 09/658,215 :
Filed: 8 September, 2000 :
Attorney Docket No.: 10636-005001 :

This is a decision on the petition under 37 C.F.R. §1.47(a), filed on 22 December, 2003.

The petition is **GRANTED**.

BACKGROUND

The record reflects that:

- this application was filed on 8 September, 2000, without, *inter alia*, an executed oath or declaration by the named inventors—i.e., it was signed by all named inventors Castiel, et al, save for John E. Draim (Mr. Draim);
- accordingly, the Office mailed a Notice of Missing Parts on 27 October, 2000, and the 6 March, 2001, and 20 September, 2001, petitions seeking status under 37 C.F.R. §1.47 were dismissed by the Office on 9 July, 2001, and 2 October, 2001, respectively;
- although Petitioner failed to timely and properly address the dismissal of 2 October, 2001, on or before Monday, 3 December, 2001—and thus the application was deemed abandoned after midnight 2 December, 2001—the Examiner nonetheless examined the application and mailed a Notice of Allowance on 7 October, 2003;
- during review prior to publication, the abandoned status of the application was discovered by the Office.

- a Communication was mailed by the Office to Petitioner on 21 May, 2004, and indicated that Petitioner had failed to reply timely and properly to the dismissal of 2 October, 2001;
- nonetheless, the 21 May, 2004, petition was dismissed on 16 June, 2004, after Petitioner argued as to some unidentified paper dated 1 September, 2000 (sic)—a date which is not at issue in this regard, and failed to reply properly to the 2 October, 2001;
- Petitioner submitted via FAX on 26 July, 2004, copies of transmittal documents, he filed the instant petition on 19 August, 2004, but despite being reminded of the reply requirement (via a telephone conference on 9 September, 2004) by the Office of Petitions, Petitioner failed to supplement his petition with the required reply—i.e., a grantable petition under 37 C.F.R. §1.47 or a petition evidencing joinder—and, therefore the petition was dismissed on 10 September, 2004;
- on 10 September, 2004, Petitioner filed a petition to revive, which was granted on 25 October, 2004;
- with the instant petition, Petitioner has shown proprietary interest/irreparable harm and that, while all of the co-inventors Castiel et al have signed the oath/declaration, save for the non-signing inventor **Mr. Draim**, who has refused or otherwise failed to join in the filing of the above-identified application after having been presented with the application papers.

Specifically, the declaration/statement/submission of facts of/by Scott C. Harris (Reg. No. 32,030) and Bing A1 (Reg. No. 43,312) establish that the non-signing inventor was mailed the application papers, including the specification, claims and drawings, but failed to respond positively to the request that they sign the declaration or in fact sign said declaration.

Lastly, Petitioner has submitted a declaration in compliance with 37 C.F.R. §1.63 and §1.64 and Petitioner has shown that such action is necessary to prevent irreparable damage.

This application and papers have been reviewed and found in compliance with 37 C.F.R. §1.47(a).

This application hereby is **ACCORDED status under 37 C.F.R. §1.47(a)**.

As provided under 37 C.F.R. §1.47(a), the Office will forward notice of this application's filing to the non-signing inventor at the address given in the petition.

Notice of the filing of this application also will be published in the Official Gazette.

This file is being forwarded to OIPE for processing as necessary to reflect the instant decision,

and then will be forwarded to Publications Branch to be processed into a patent.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.



John J. Gillon, Jr.
Senior Attorney
Office of Petitions



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OFFICE OF PETITIONS

In re Application of
Castiel, et al :
Application No. 09/658,215 :
Filed: 8 September, 2000 :
Attorney Docket No.: 10636-005001 :
:

COMMUNICATION

Dear John E. Draim:

You are named as inventor in the above-identified United States patent application, filed under the provisions of 35 U.S.C. §116 (United States Code), and 37 C.F.R. §1.47, ¶a, Rules of Practice in Patent Cases.

Should a patent be granted on the application you will be designated therein as inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 C.F.R. §1.19) or make your position of record in the application.

Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 C.F.R. §1.63.

Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733.

Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703) 308-9726 or toll-free: (800) 972-6382 (outside the Washington D.C. area).

Telephone inquiries concerning this correspondence may be directed to the undersigned at (703) 305-9199.



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